

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NORBERT ZIMMERMANN

Appeal No. 2001-0459
Application 09/171,769

ON BRIEF

Before HAIRSTON, KRASS and JERRY SMITH, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 3 and 5-7, which constitute all the claims remaining in the application.

The disclosed invention pertains to an auxiliary switch block for attachment to a device. The conventional auxiliary switch block is shown in Figure 2 of the application and is disclosed to have problems when coupled to a basic device. The auxiliary switch block of the invention, as shown in Figure 1 of the application, has an extension arrangement 3 provided on the contact carrier 2 which is specifically designed for engagement with a guide of an interrupter chamber.

Representative claim 3 is reproduced as follows:

3. An auxiliary switch block for attachment to a device, comprising:

a guiding arrangement for guiding a first contact carrier in an interrupter chamber of the auxiliary switch block;

a coupling point arrangement positioned on a side of the first contact carrier for engaging a second contact carrier, the second contact carrier being a contact carrier of the device;

the first contact carrier including pairs of windows, a height of the first contact carrier corresponding to a height of the pairs of windows; and

an extension arrangement positioned on the first contact carrier opposite to the coupling point arrangement, the extension arrangement extending over the height of the first contact carrier, reaching into a region of the interrupter chamber, projecting beyond the first contact carrier, and engaging with the guiding arrangement in the region of the interrupter chamber.

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The examiner relies on the following references:

Pollmann et al. (Pollmann)	3,942,143	Mar. 02, 1976
Kuhn et al. (Kuhn)	4,087,770	May 02, 1978
Haas	5,717,370	Feb. 10, 1998
		(filed Feb. 14, 1996)

Claims 3 and 5-7 stand rejected under 35 U.S.C. § 103.

As evidence of obviousness the examiner offers Pollmann in view of Kuhn and Haas.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill

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in the art the obviousness of the invention as set forth in claims 3 and 5-7. Accordingly, we reverse.

Appellant has indicated that for purposes of this appeal the claims will all stand or fall together as a single group [brief, page 3]. Consistent with this indication appellant has made no separate arguments with respect to any of the claims on appeal. Accordingly, all the claims before us will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejection against independent claim 3 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some

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teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision.

Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellant [see 37 CFR § 1.192(a)].

The examiner indicates how he finds the claimed invention to be obvious over the applied prior art on pages 3-4 of the answer. Appellant argues that there is no teaching, suggestion, incentive or motivation to combine the prior art in the manner proposed by the examiner. Appellant also argues that the problem solved by the specific claimed extension arrangement positioned opposite to a coupling point is not taught or suggested by any of the applied references [brief, pages 3-6]. The examiner responds that the three applied references are all related to problems within the contactor art. The examiner also asserts that it would have been obvious to combine Kuhn and Haas with Pollmann to enable multiple switching functions to be executed by the Pollmann contactor and to reduce the size of the device [answer, pages 5-7]. Appellant responds that the examiner has resorted to improper hindsight because Pollmann, Kuhn and Haas are all silent as to a suggestion or teaching for combining these references. Appellant also responds that the combination of Pollmann, Kuhn and Haas still fails to teach the extension arrangement as recited in claim 3. Finally, appellant argues that Pollmann

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teaches away from the claimed invention because Pollmann relates to a single contact carrier and not to two contact carriers as claimed [reply brief].

We will not sustain the examiner's rejection of the claims on appeal. We agree with appellant that the examiner's proposed combination of Pollmann, Kuhn and Haas is based on an improper attempt to reconstruct the claimed invention in hindsight. The examiner has not identified any specific portions of the applied prior art which specifically support the examiner's asserted motivations for combining the applied prior art. The examiner's generalized motivations to combine appear to be based on the examiner's own opinions rather than on specific suggestions found within the applied prior art. Since the examiner has not identified any specific portions of the applied prior art which support the proposed combination, we must conclude that the only basis for combining these references is to reconstruct the claimed invention in hindsight. Such a hindsight reconstruction of the invention is improper.

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In summary, we have not sustained the examiner's rejection of the claims on appeal. Therefore, the decision of the examiner rejecting claims 3 and 5-7 is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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ERROL A. KRASS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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